

**REMARKS**

**I. Status of the Application**

Claims 1-16 are all the claims pending in the application, with claims 1 and 15-16 being in independent form. Claims 1-16 have been rejected.

The present Response addresses each point of objection and rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

**II. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kahn**

The Examiner has rejected claims 1-2, 9 and 12-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,029,065 to Shah (hereinafter “Shah”), in view of U.S. Patent No. 5,745,852 to Khan *et al.* (hereinafter “Khan”). Applicant respectfully traverses these rejections for *at least* the independent reasons stated below.

**A. Independent Claim 1**

The Examiner acknowledges that Shah fails to teach or suggest the feature of connecting a communication terminal of a first network to a private base, as recited in claim 1. (08/25/05 Office Action, page 2). Applicant agrees with the Examiner that Shah fails to teach or suggest this feature. Nevertheless, the Office Action alleges that Shah teaches connecting a Mobile Station 100 to a public Base Station 200. In addition, the Office Action applies Khan, alleging that Khan teaches that a mobile station 10 is connected to a private base station 20, thereby enabling the connection of the mobile station 10 with the network of the private base station 20. (08/25/05 Office Action, page 3). Further, the Office Action alleges that it would have been obvious to one of ordinary skill in the art to combine the teachings of Shah and Khan to arrive at

the recitations in claim 1, and alleges that the motivation for doing so would be “for the simple purpose of permitting the user to take advantage of the reduced call cost of the private base.” (08/25/05 Office Action, page 3). Applicant respectfully disagrees with the Office Action.

First, Applicant submits that the Office Action has failed to establish even a *prima facie* case of obviousness because it has failed to provide a proper motivation to combine the cited references in the manner of Applicant’s claimed invention. To establish a *prima facie* case of obviousness the Examiner must establish that there is some suggestion or motivation, in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. (See MPEP § 2143).

The motivation for combining the teachings of Shah and Kahn cited by the Office Action is “for permitting the user to take advantage of the reduced call cost of the private base.” (08/25/05 Office Action, page 3). However, the Office Action does not point to any specific portion of the cited references to support such a motivation to combine the reference teachings. In fact, the Office Action does not provide any evidentiary support whatsoever for this alleged motivation. Nevertheless, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). And, this burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. (*In re Lalu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984)). Indeed, unsupported statements and conclusions of obviousness are considered inadmissible hindsight. (See, e.g., *In re Geiger*, 2 USPQ2d 1276 (Fed. Cir. 1987), *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987), *In re*

*Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), *Ex parte Clapp*, 227 USPQ 972 (Pat. Off. Bd. App. & Inter. 1985), *Ex parte Shepard and Gushue*, 188 USPQ 537 (Pat. Off. Bd. App. 1974)).

Since the Office Action has not provided any evidentiary support whatsoever to support the alleged motivation to combine the teachings of Shah and Khan, the Office Action has failed to establish even a *prima facie* case of obviousness for *at least* these reasons.

Second, Applicant submits that one of ordinary skill in the art would not have been motivated to combine the teachings of Shah and Khan in the manner proposed by the Office Action to arrive at the recitations in claim 1. Most if not all inventions arise from a combination of old elements. (*In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. (*Id.*) However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. (*Id.*) Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant (emphasis added). (*In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984))).

Here, the Office Action alleges that it would have been obvious to one of ordinary skill to combine the teachings of Shah, regarding connecting a Mobile Station 100 to a public Base Station 200 and converting a first set of feature codes recognized by the public Base Station 200 to a second set of feature codes recognized by the Mobile Station 100, with the teachings of

Kahn that a mobile station 10 is connected to a private base station 20, to arrive at the invention recited in claim 1. (08/25/05 Office Action, page 3). Applicant respectfully disagrees.

The fundamental objective of Shah is to provide a method for remote feature code programming and conversion for a visiting mobile station (i.e., a visiting mobile station which is accessing a public base station, rather than the mobile station's home network). (Column 3, lines 25-53). Therefore, Shah is directed to providing a user-transparent means for a visiting mobile user to access a visited network connected to a visited public base station, without requiring knowledge of the visited network's specific feature codes. (Column 3, lines 16-19). In short, Shah is directed to a means for facilitating the network access of a visiting mobile station, as the visiting mobile station moves from the coverage area of a home public base station to the coverage area of a visiting public base station.

Since Shah is directed to a means for facilitating a visiting mobile station's access to a visited network via a visited public base station, Applicant submits that one of ordinary skill in the art would not have been motivated to look toward the teachings of Khan, which is directed to the entirely different operation of registering a mobile station with a private base station connected to a private land-line subscriber telephone (i.e., a home private base station). In fact, Khan specifically teaches away from such a proposed combination, in that, Khan teaches that private base stations operate at a greatly reduced power level than the public base stations of large cells. (Column 1, lines 22-23). As such, Khan teaches that such private base stations would not be suitable for providing access to a visiting mobile station, like that taught in Shah.

Indeed, as taught in Kahn, private base stations are exactly that—private—and do not permit access to the visiting public.

Accordingly, Applicant submits that the Office Action has failed to identify any specific suggestion or teaching of the desirability of combining the means for facilitating a visiting mobile station's access to a visited network via a visited public base station, as taught in Shah, with the private base station taught in Khan, to arrive at the invention recited in claim 1. To the contrary, Khan explicitly teaches away from the Office Action's proposed combination. Therefore, Applicant respectfully submits that independent claim 1 is patentable over Shah, Khan, and any combination thereof, for *at least* these independent reasons. Further, Applicant respectfully submits that the dependent claims 2-14 are allowable, *at least* by virtue of their dependency on claim 1.

Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

**B. Independent Claim 15**

In view of the similarity between the recitations of claim 15 and the recitations discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 15. As such, it is respectfully submitted that claim 15 is patentably distinguishable over the cited Shah and Khan references *at least* for reasons analogous to those presented above. Thus, the allowance of this claim is respectfully solicited of the Examiner.

**C. Independent Claim 16**

In view of the similarity between the recitations of claim 16 and the recitations discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 16. As such, it is respectfully submitted that claim 16 is patentably distinguishable over the cited Shah reference *at least* for reasons analogous to those presented above. Thus, the allowance of this claim is respectfully solicited of the Examiner.

**III. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Khan and further in view of Sipilä**

The Examiner has rejected claim 3 as being unpatentable over Shah, in view of Khan, and further in view of European Patent Application No. EP 0 748 136 to Sipilä (hereinafter “Sipilä”). Applicant respectfully traverses this rejection for *at least* the independent reasons stated below.

Claim 3 incorporates all the novel and non-obvious limitations of its base claim 1. As set forth above, the Office Action has failed to provide a proper motivation for combining the teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Office Action. Moreover, Sipilä also fails to remedy these deficiencies. Therefore, Applicant respectfully submits that claim 3 is patentable over Shah, Kahn, Sipilä, and any combination thereof, for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

**IV. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kahn, further in view of Sipilä, and further in view of Kasmperschroer**

The Examiner has rejected claims 4 and 6-7 as being unpatentable over Shah, in view of Khan, in view of Sipilä, and further in view of U.S. Patent No. 6,434,399 to Kasmperschroer (hereinafter “Kasmperschroer”). Applicant respectfully traverses these rejections for *at least* the independent reasons stated below.

Claims 4 and 6-7 incorporate all the novel and non-obvious limitations of their base claim 1. As set forth above, the Office Action has failed to provide a proper motivation for combining the teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Office Action. In addition, both Sipilä and Kasmperschroer also fail to remedy these deficiencies. Hence, Applicant respectfully submits that claims 4 and 6-7 are patentable over Shah, Kahn, Sipilä, Kasmperschroer, and any combination thereof, for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

**V. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kahn, further in view of Sipilä, further in view of Kasmperschroer, and further in view of Heuvel**

The Examiner has rejected claim 5 as being unpatentable over Shah, in view of Khan, in view of Sipilä, in view of Kasmperschroer, and further in view of U.S. Patent No. 5,924,014 to Heuvel *et al.* (hereinafter “Heuvel”). Applicant respectfully traverses this rejection for *at least* the independent reasons stated below.

Claim 5 incorporates all the novel and non-obvious limitations of its base claim 1. As set forth above, the Office Action has failed to provide a proper motivation for combining the teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Office Action. Moreover, Sipilä, Kasmperschroer, and Heuvel all fail to remedy these deficiencies. Therefore, Applicant respectfully submits that claim 5 is patentable over Shah, Kahn, Sipilä, Kasmperschroer, Heuvel and any combination thereof, for *at least* these independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

**VI. Claim Rejections under 35 U.S.C. § 103 – Shah in view of Kahn, further in view of Kasmperschroer**

The Examiner has rejected claims 8-11 as being unpatentable over Shah, in view of Khan, and further in view of Kasmperschroer. Applicant respectfully traverses these rejections for *at least* the independent reasons stated below.

Claims 8-11 incorporate all the novel and non-obvious limitations of their base claim 1. As set forth above, the Office Action has failed to provide a proper motivation for combining the teachings of Shah with those of Kahn to arrive at the invention recited in claim 1. Further, as discussed above, one of ordinary skill would not have been motivated to combine the teachings of Shah and Kahn in the manner proposed by the Office Action. Moreover, Kasmperschroer also fails to remedy these deficiencies. Therefore, Applicant respectfully submits that claims 8-11 are patentable over Shah, Kahn, Kasmperschroer, and any combination thereof, for *at least* these



independent reasons. Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

**VII. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

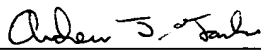
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**23373**

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